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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,790	11/30/2001	David Leigh Donoho	UNIV0001D3-C	6114

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EXAMINER	
CARDONE, JASON D	
ART UNIT	**PAPER NUMBER**
2145	3

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,790	DONOHO ET AL.	
	Examiner	Art Unit	
	Jason D Cardone	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Attached Office Action*.

DETAILED ACTION

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. Claim 1 is objected to because of the following informality, "accesseing" should be "accessing". Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-24 of USPN 6,263,362 contains every element of claims 1-41 of the instant application and as such anticipates claims 1-41 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, USPN 5,761,662, in view of Rose et al. "Rose", USPN 5,724,567.

9. Regarding claim 1, Dasan discloses a method for inspecting any of the properties of a computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers, comprising the steps of:

providing at least one inspector library, which includes at least one library and associated methods [ie. user profiles, Dasan, col. 6, lines 1-19], evaluating subexpressions with the at least one inspector [ie. using user profile, Dasan, col. 6, lines 20-60].

Dasan does not specifically disclose the inspector performing any of mathematico-logical calculations, executing computational algorithms, returning results of system calls, accessing contents of storage devices, and querying devices or remote computers to inspect any of the properties of the computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers. However, Rose, in the same field of endeavor, discloses an inspector that performs mathematico-logical calculations and querying devices or remote computers [ie. server (10), Rose, col. 3,

lines 37-65 and col. 6, line 62 - col. 7, line 62]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2, line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

10. Regarding claim 2, Dasan-Rose further discloses providing an inspector dispatcher associated with an advice client computer for continually performing relevance determination; wherein the relevance determination is driven by a database of relevance clauses, which can be continually evaluated [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

11. Regarding claim 3, Dasan-Rose further discloses sending certain relevance clauses to a remote location, evaluating the clauses, and returning the clauses after a user is made aware of what is being transferred, wherein properties of the remote location are learned [Dasan, col. 6, lines 1-19] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

12. Regarding claim 4, Dasan-Rose further discloses relevance evaluation is driven in a master-slave relationship by a master machine, which tells a slave machine to evaluate a relevance clause [Dasan, col. 7, line 61 – col. 8, line 21] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

13. Regarding claim 5, Dasan-Rose further discloses properties, which can be learned, are elementary properties that are determined according to basic calculations [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

14. Regarding claim 6, Dasan-Rose further discloses the at least one inspector is built into the inspector dispatcher [ie. newspaper generator, Dasan, col. 5, line 53 - col. 6, line 9] [Rose, col. 3, lines 37-65].

15. Regarding claim 7, Dasan-Rose further discloses providing one or more caches for avoiding heavy CPU and disk access overhead while successfully performing the continual relevance evaluation [Dasan, col. 7, line 61 – col. 8, line 21] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

16. Regarding claim 8, Dasan-Rose further discloses an object, property name, and/or string selector is dispatched to the inspector dispatcher for relevance evaluation using a method dispatch module in accordance with dispatch information contained

within a method dispatch table [Dasan, col. 5, line 53 - col. 6, line 9] [Rose, col. 3, lines 37-65].

17. Regarding claim 9, Dasan-Rose further discloses parsing a clause in a relevance language, generating a list of method dispatches in response to the parsing step, wherein specific methods are called in a specific order with specific argument lists; and systematically carrying out a sequence of method dispatches in an appropriate order [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

18. Regarding claims 10-41, claims 10-41 have similar limitations as claims 1-9. Therefore, they are rejected under Dasan-Rose for the same reasons set forth in the rejection of claims 1-9 [Supra 1-9].

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason D Cardone
Primary Examiner
Art Unit 2145

September 28, 2004